

REMARKS

Claims 1-174 and 187-198 have been cancelled. Claims 175-186 and 199-208 remain in the prosecution.

Rejections of the Claims

Rejections under 35 U.S.C. §103(a)

In the Final Office Action dated February 12, 2007 ("Final Office Action"), claims 175-196 and 199-208 were rejected under 35 U.S.C. §103(a) as being unpatentable over Perry (US 5,241,466 or "Perry") in view of Krim (US 2002/0072925 or "Krim") and further in view of Mindrum et al (US 6,340,978 or "Mindrum"), "for substantially the same reasons given in the previous Office Action..." (Non-Final Office Action dated April 5, 2006 or "Non-Final Office Action").

In the Non-Final Office Action at Page 4, the Examiner states:

...In particular, Mindrum suggests that the method having providing via said interface guidance information comprising at least one input form, said at least one input form comprising electives available to said participant regarding said future care (See Mindrum, Col. 4, lines 13-67), and reference information associated with said available electives (See Mindrum, Col. 4, lines 13-67);

analyzing said available electives in response to input by said input user to provide via said interface analysis information regarding said future care to allow informed choices of said electives to be made (See Mindrum, Col. 3, lines 27-67)...

Yet, in the Final Office Action, the Examiner contradicts this statement. In response to Applicant's arguments (See Applicant's Response of October 3, 2006, pages 5-6) that Mindrum neither teaches nor suggests the above-cited elements, the Examiner states (See Final Office Action at Page 5):

...Examiner respectfully submitted that He relied upon the clear and unmistakable teaching of Krim Page 5, Paragraphs 0064-0065). Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained.

...Examiner respectfully submitted that He relied upon the clear and unmistakable teaching of Krim Page 2, Paragraphs 0027). Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained.

The Examiner cited Mindrum in the Non-Final Office Action. In responding, Applicant relied upon the Examiner's citation of Mindrum. Yet, in the Final Office Action, the Examiner contradicts himself by claiming he cited Krim. Both cannot be true. Yet, instead of making the most recent office action non-final (and allowing Applicant an opportunity to respond to Krim), the most recent office action was made final. Applicant respectfully traverses the Examiner's decision to make the most recent office action final.

Pursuant to 35 U.S.C. §132 (a), whenever a claim for a patent is rejected, the Examiner is required to provide the Applicant with the reasons for such a rejection, with "such information and references as may be useful in judging of the propriety of continuing the prosecution of the application." As a matter of law, the unsupported final rejection fails to comply with 35 U.S.C. § 132, because it "is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection." *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990). Such tactics delay the prosecution of the application, because if there is going to be a final rejection of one or more of Applicant's claims, pursuant to MPEP §707.07, "a clear issue should be developed between the examiner and applicant." Accordingly, this is Applicant's first opportunity to respond to Krim as raised by the Examiner for the first time in the Final Office Action.

The Examiner still cannot establish a *prima facie* case of obviousness based upon Krim, because Krim does not teach nor suggest Applicant's element of "analyzing said available electives in response to input by said input user to provide via said interface analysis information regarding said future care to allow informed choices of said electives to be made." Pursuant to

MPEP §2143, to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all of Applicant's claim limitations. Here, the Examiner can not meet this burden.

Applicant's claim 175 recites (emphasis added):

A method of providing a plurality of participants with the ability to effect choices about the future care of said participants, said method comprising

receiving from an input user, via an interactive user interface accessible through the internet, raw data relevant to the future care of a participant should said participant prior to death become incapacitated;

providing via said interface guidance information comprising at least one input form, said at least one input form comprising electives available to said participant regarding said future care, and reference information associated with said available electives; [and]

analyzing said available electives in response to input by said input user to provide via said interface analysis information regarding said future care to allow informed choices of said electives to be made;

receiving from said input user via said interface at least one election of at least one of said electives;

providing said input user an identification instrument comprising a unique identification parameter corresponding to said participant;

storing in a computer-readable registry end-of-life information and said unique identification parameter in the form of an information set corresponding to said participant, said end-of-life information comprising said received raw data and said at least one election;

receiving a request from an output user identifying the occurrence of an incapacitated state in said participant;

verifying that said request includes said unique identification parameter;
if so, generating an information product derivative of said information set comprising said participant's election corresponding to said incapacitated state, said information product being generated in a form that is enforceable in the jurisdiction from which said request was received;
and

communicating said information product to an output recipient.

In the Final Office Action, the Examiner cites Krim Paragraph 0027 for the proposition that Krim teaches or suggest Applicant's element of "analyzing said available electives in response to input by said input user to provide via said interface analysis information regarding said future care to allow informed choices of said electives to be made." It does not.

Krim Paragraph 0027 states (emphasis added):

[0027] For instance, some messages may be designated to be sent in case of severe illness, injury, incapacitation, or imminent death. These messages might include a preference for a particular hospital or hospice, a living will specifying desired aggressiveness of treatment, etc., a designation of a health care proxy, organ donation designations (which organs or tissues may be donated, and for what uses--transplantation or treatment, medical study, etc.).

Indeed, Krim FIG. 4B illustrates Krim Paragraph 0027 as a way to send email messages *to others* upon the occurrence of certain future events:

FIG. 4B

Accordingly, Krim's sending of some messages in case of severe illness, injury, incapacitation, or imminent death does not teach nor suggest Applicant's claim limitation of "analyzing said available electives in response to input by said input user to provide via said interface analysis information regarding said future care to allow informed choices of said electives to be made." Among other things, Krim's purported "analysis" of possible future contingencies results in the providing of email messages to people other than the participant. Krim does not remotely teach nor suggest Applicant's "analyzing said available [future care] electives ... to provide ... information regarding said future care..."

The Applicant notes that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *See In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (underlining in the original). Such facts and technical reasoning are lacking with respect to the disclosure of Krim. A *prima facie* case of obviousness requires that "all the claim limitations" be disclosed in the cited art. Said disclosure lacking, the Applicant contends that the Examiner's obviousness rejection is overcome. MPEP § 2142.

Further, *Richardson v. Suzuki Motor Co.* requires that with respect to the prior art, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added). Krim clearly fails in this regard, as it does not teach nor suggest Applicant's "analyzing said available electives in response to input by said input user to provide via said interface analysis information regarding said future care to allow informed choices of said electives to be made." Again, the Applicant contends that the Examiner obviousness rejection is overcome. MPEP § 2142.

The legal concept of *prima facie* obviousness is a procedural tool of examination that "allocates who has the burden of going forward with production of evidence in each step of the

examination process.” MPEP § 2142 (citing *In re Rinehart*, 531 F.2d 1048 (CCPA 1976)). In that regard, “[t]he examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness”; “the applicant is under no obligation to submit evidence of nonobviousness” if the Examiner fails in this regard. MPEP § 2142. The Applicant respectfully contends the Examiner has failed to evidence the aforementioned *prima facie* case of obviousness not only with respect to the absent claim element referenced in the context of Krim but through the lack of any motivation to combine the Krim, Perry and Mindrum references.

A *prima facie* case of obviousness, in addition to the ‘each and every element’ requirement addressed above also requires “some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” MPEP § 2142. “The teaching or suggestion to make the claimed combination . . . must . . . be found in the prior art, and not based on [the] applicant’s disclosure.” MPEP § 2142 (citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991)).

Despite the Examiner’s contention in the Final Office Action (Page 4) that the Examiner’s combination of references is “based on the logic and scientific reasoning of one of ordinary skill in the art at the time of the invention that support a holding of obviousness...” the Examiner’s sole basis for combining Krim, Perry and Mindrum in the Non-Final Office Action (Page 5) is “the motivation of providing a user interface which can be accessed over a computer, either as stand-alone or a network, or as in memorial such as in a headstone.” This recitation provided by the Examiner is not a motivation to combine but a summarization of the Applicant’s claimed invention. Motivation to combine requires that the references or the art “expressly or impliedly suggest the claimed invention” or “why the [skilled] artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Merely reiterating the nature of claimed invention is insufficient and expressly contra to the United States Court of Appeals for the Federal Circuit’s holding *In re Vaeck*. As such, the Applicant again contends the Examiner’s obviousness rejection to have been overcome.

Last, in the Final Office Action, the Examiner completely fails to address Applicant's argument regarding "applicants are their own lexicographers..." (See Applicant's October 3, 2006 Response, Pages 4-5). Applicant argued—and reiterates here—that during patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." (quoting *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (emphasis added)). That interpretation is made "in light of the specification as it would be interpreted by one of ordinary skill in the art." (citing *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (emphasis added)). Further, "the terms and phrases used in the claims must find clear support . . . in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." (citing 37 C.F.R. § 1.75(d)(1) (emphasis added)). Notwithstanding this analysis and subsequent argument, the Examiner offers no response through the present rejection.

CONCLUSION

Based on the foregoing remarks, Applicant believes the application is in condition for allowance. If the Examiner has any questions regarding the case, the Examiner is invited to contact Applicant's undersigned representative.

Respectfully submitted,

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